

Confirmation No. 6063

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	AMTMANN	Examiner:	Khan, Omer
Serial No.:	10/562,244	Group Art Unit:	2612
Filed:	December 22, 2005	Docket No.:	AT030034US1 (NXPS.610PA)
Title:	METHOD OF MAKING AN INVENTORY OF TRANSPONDERS IN A COMMUNICATION STATION		

REPLY BRIEF

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P.O. Box 1450
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Dear Sir:

This is a Reply Brief submitted pursuant to 37 C.F.R. § 41.41(a)(1) for the above-referenced patent application. This Reply Brief is submitted in response to the Examiner's Answer dated June 9, 2010.

Authorization is given to charge/credit **Deposit Account 50-4019 (AT030034US1)** all required fees/overages to enter this paper.

I. Status of Claims

Claims 1-11 stand rejected and are presented for appeal.

II. Grounds of Rejection

The grounds of rejection to be reviewed on appeal are as follows:

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) over Cato (U.S. Patent No. 5,539,394) in view of Pavesi (U.S. Patent No. 6,549,536).

III. Appellant's Reply Argument

1. The Asserted Combination Of References Does Not Correspond; The Cited "Hashed Number" Neither Identifies A Distinguishing Transponder Dataset, Nor Is Used To Access The Same.

As argued in Appellant's Appeal Brief, the cited combination of references fails to establish correspondence to claim limitations directed to generating a hash value in a transponder, where the hash value identifies part of a distinguishing dataset in the transponder, and further to using the hash value to access the (stored) part of the distinguishing dataset. These limitations are applicable to various example embodiments addressing problems such as those related to overcoming the need to generate hashing data in a communication station, and to transmitting that hashing data to each of a plurality of transponders (*see, e.g.*, page 2:7-23 of Appellant's specification).

In contrast, the cited "hashed number" in the '394 reference is simply a remaining number of time slots, as corresponding to a mathematical remainder upon dividing a tag ID by a total number of time slots (*see* column 5:22-55). The '394 reference further requires that a "hashing base number," which is the aforesaid total number of timeslots, be generated externally from the tag at a reader. In this context, the cited "hashed number" (alleged as corresponding to the claimed hash value) *is* an actual time slot that is used by the tag, and neither identifies part of a distinguishing dataset (including the asserted tag ID), nor permits access to part of any such distinguishing dataset in accordance with the claimed invention or otherwise.

The Examiner's Answer fails to rebut the above discussed lack of correspondence, as further established in the record (prior to Appeal), to which the Examiner has offered no

substantive rebuttal. Instead of evidence supporting the rejection, the Examiner's Answer asserts at page 10 that "[i]t is the Examiner's interpretation that Cato's transponder is capable of generating the hash value." However, no evidence has been provided in support of this new "interpretation," which fails to address the lack of correspondence as summarized above, discussed in Appellant's Appeal Brief and further established in the record. For example, the Examiner's Answer does not provide any explanation as to how the '394 reference uses the cited "hashed number" at column 5:50-55 to either identify part of a distinguishing dataset or for accessing part of the distinguishing dataset. As the cited "hashed number" is simply the remaining number of time slots upon division with a tag ID, nothing in the record supports the Examiner's (new) assertion regarding alleged capabilities of the '394 reference. The cited portions of the secondary '536 reference also fail to address the above discussed shortcomings of the '394 reference (and is instead asserted as providing correspondence to looking up a hash number).

As the Examiner's Answer is otherwise silent as to this lack of correspondence to limitations directed to generating a hash value that identifies part of a distinguishing dataset, and using the hash value to access part of the distinguishing dataset, the rejections cannot be maintained. Appellant therefore requests that all rejections be reversed.

2. The Examiner's Answer Has Impermissibly Introduced New Grounds Of Rejection In Attempting To Allege Correspondence.

In attempting to address the lack of correspondence as established in the Appeal Brief (as consistent with Appellant's traversals of record), the Examiner's Answer introduces new grounds of rejection at page 10, in contrast with M.P.E.P. § 1208.01 and applicable law. Specifically, "a 'ground of rejection' for purposes of Rule 1.192(c)(7) is not merely the statutory requirement for patentability that a claim fails to meet but also the precise reason why the claim fails that requirement." *See, e.g., Hyatt v. Dudas*, 551 F.3d 1307, 1312 (Fed. Cir. 2008); *see also In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976). Accordingly, it is not proper to materially change the precise reason for the rejection without acknowledging that such a change represents a new ground of rejection. As applicable here, the Examiner's Answer has modified the reason upon which the rejection relies in asserting correspondence,

in alleging that “[i]t is the Examiner’s interpretation that Cato’s transponder is capable of generating the hash value” in accordance with the claimed invention. This assertion appears to amount to an allegation that the generation of the cited “hashed number” inherently involves generating a hash value that identifies (per claim 1) “a part of a distinguishing dataset that is stored in the transponder.”

Aside from noting that such assertions as to what the transponder would be “capable” of doing if modified is insufficient to establish correspondence (further discussed above in Section 1), Appellant submits that such new arguments are contrary to the requirements of the M.P.E.P. and relevant law as cited above. This new grounds involving an apparent allegation of inherency improperly modifies the rationale upon which the rejection is based, thus depriving the Appellant of an opportunity to traverse the new grounds and alleged inherency, present evidence, amend claims or otherwise respond to the rejection. Further in view of the clear lack of correspondence in the cited “hashed number” as discussed above, the alleged inherency is not only baseless, it fails because the ‘394 reference itself defines the hashed number as corresponding to something that is different (a remaining number of time slots) than the Examiner’s assertions of inherency.

The Examiner’s Answer further relies upon additional new grounds of rejection at page 12, in asserting new rationale for combining the packet-based routing functions of the secondary ‘536 reference with the RFID functions of the primary ‘394 reference. Specifically, the first four paragraphs at page 12 of the Examiner’s Answer, beginning with the statement that “[i]t is the Examiner’s interpretation” and involving an assertion that combinations may be made simply because references both entail “electronic communications” would appear to significantly modify the previously-provided rationale for combining references (to “reduce the chance of collision”). Appellant submits that such new arguments also impermissibly modify the rationale upon which the rejections are based. Moreover, these new arguments lack any explanation as to how the discussed “method of address compression for cell-based and packet-based communication protocols” applies to the tags of the ‘394 reference, or how any and all components of devices carrying out “electronic communications” are completely interchangeable, regardless of their respective disparities.

Accordingly, it would appear that absent reversal of all rejections and allowance of all claims for other reasons as presented herein (*e.g.*, due to lack of correspondence as consistent with Section 1 above), the appropriate course of action would be to reopen prosecution to present this new grounds of rejection.

3. The Examiner's Reliance Upon "Simple Substitution" Under *KSR* Fails To Address Differences In The Cited References That Contradict The Examiner's Assertions Of Direct Substitution.

In its Appeal Brief, Appellant argued that the Examiner failed to provide any explanation as to how the seemingly unrelated teachings of the cited '394 and '536 references would (or could) be combined, and that the Examiner failed to provide a valid reason why the skilled artisan would combine such unrelated teachings. This is particularly relevant here as the teachings of the primary reference are in one field (identification tags) and the teachings of the secondary reference are in a completely different field (IP routers). As explained by the *KSR* Court, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known."¹ This is also consistent with M.P.E.P. § 2143.01 as applicable to the *KSR* decision, iterating that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (emphasis in original).

The Examiner's Answer attempts to address Appellant's traversals, but relies upon an improper assertion that the *KSR* decision permits the substitution of components without basis. Specifically, page 10 of the Examiner's Answer asserts that "[p]er *KSR* this will be simple substitution of one known element for the other in prior art." Pages 12 and 13 of the Examiner's Answer also assert that "*KSR*'s simple substitution can also be used to make the case of obviousness" and further attempts to support the replacement/substitution of elements via the assertion that "both references are discussing electronic communications." The Examiner's Answer thus effectively asserts that components of any and all devices involved in

¹ *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418-419 (2007)

“electronic communications” can be substituted for one another under *KSR*, without explanation.

In reply, Appellant submits that the Examiner’s attempt at interchanging components and functionality as asserted cannot be relied upon in support of a § 103 rejection where the Examiner has provided no reasonable explanation for combining the references. For instance, Examiner has failed to comply with § 103 and *KSR* (as discussed above) in asserting that the skilled artisan would combine teachings of the ‘536 reference relating to an IP router with the identification tags of the ‘394 reference to “reduce the chance of collision” and to do so simply because “both references are discussing electronic communications.” However, the Examiner’s Answer fails to address Appellant’s traversals explaining that the alleged “chance of collision” is completely inapplicable to the claimed invention and the proposed combination of references, and accordingly fails to explain how any such packet-based collision applies. No explanation has been provided as to how the proposed combination would function in any manner, much less how to reduce such a chance of collision. The record is thus devoid of a clearly-articulated reason that would comply with the *KSR* decision (*see, KSR* at 418-419, cited above). Unlike *KSR*, in which the combination at hand involved combining “two known devices according to their established functions,” the Examiner’s proposed combination instead involves an unexplained combination in which an identification tag is modified using aspects taken from an IP router. These disparate applications do not lend themselves to a simple combination in which the elements simply perform the same function, and the Examiner has not articulated any explanation beyond simply identifying elements and concluding that one would somehow arrive at an obvious and advantageous combination.

While Appellant believes the above discussion is sufficient to address this issue, the following detailed explanation is offered in an effort to provide further examples as to the incompatibility of the cited references, and the related impropriety of the proposed combination of references. As established in the (uncontested) record, the ‘536 reference fails to make any mention of the tags 10 taught by the ‘394 reference or of using a computed hash value to look up an identifier stored in the apparently nonexistent tags. Instead, the ‘536 reference teaches that an IP router computes a hash value from an incoming identifier, with

the computed hash value pointing to a hash table that corresponds to one or more out-coming identifiers for devices attached to the router (*see, e.g.*, column 3:4-52). In this context, the hash value of the '396 reference is not generated in a tag, the hash value does not identify any data stored in the tag, the hash value is not used to access data stored in the tag, and the hash value is not used in any manner to compute a time slot in which the tag communicates with a reader, as in the claimed invention. At best, the proposed combination would involve (extensively) modifying the cited teachings of the '394 reference in some as yet unidentified manner. Moreover, the '394 reference already addresses the problem of collisions through the use of unique time slots. As such, the record is devoid of any evidence establishing that the proposed combination would operate to reduce the chance of collision in the '394 reference (*i.e.*, that the proposed rationale for combining references applies). Accordingly, the Examiner's assertion of such a vague "articulated reasoning" (*e.g.*, to "reduce the chance of collision") in support of the modification is insufficient to maintain the § 103 rejections..

In view of the above, the Examiner's legal conclusion of obviousness cannot be maintained in view of the evidence of record. Accordingly, the § 103(a) rejection of claims 1-11 is improper and Appellant requests that it be reversed.

4. The '394 Reference Teaches Away From The Proposed Combination.

As established in Appellant's Appeal Brief, the Examiner's proposed modification of the '394 reference is improper because the '394 reference teaches away from using its hashed number to access a part of a distinguishing dataset stored in a tag, and further using the accessed part to calculate a transmission parameter (*e.g.*, a time slot) for the tag. Consistent with the above-cited *KSR* decision and M.P.E.P. § 2143.01, a §103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main ('394) reference - the rationale being that the prior art teaches away from such a modification. *See KSR* at 418-419 (2007), reciting that "when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."

In this instance and as consistent with the above, the '394 reference divides the tag's serial number by a hashing base number (total available time slots as provided by the reader)

to determine a hashing number as a remainder (remaining number of time slots), which is the actual time slot in which the tag will transmit its serial number to the reader. *See, e.g.*, column 5:48-55. As the tag of the '394 reference has already determined its time slot, the '394 reference teaches away from additional steps involving using the hashing number to access a part of a distinguishing dataset stored in the tag and then using the accessed part to calculate a time slot for the tag. Appellant submits that the skilled artisan would not add these additional unnecessary steps to the '394 reference because the '394 reference has already determined the tag's time slot.

In attempting to address the above-discussed teaching away, the Examiner's Answer asserts that "[i]t is the Examiner's position that it is obvious that one would want to make sure that the computed time slot is one of the available time slots." The Examiner again goes on to discuss collision avoidance, but fails to provide any explanation for (or generally address in any manner) adding steps as discussed above.

In reply, Appellant submits that the Examiner's assertion regarding time slots fails to address the issue at hand, which now stands uncontested. Specifically, the Examiner's Answer has failed to rebut Appellant's traversals of record, regarding the lack of motivation for using the hashed number of the '394 reference to access a part of a distinguishing dataset stored in the tag and then using the accessed part to calculate a time slot for the tag. The record lacks any evidence or rationale for explaining how or why skilled artisan would add these additional unnecessary steps to the '394 reference, particularly in view of the fact that the '394 reference has already determined its tag's time slot.

Accordingly, the '394 reference teaches away from the Examiner's proposed modification and there is no motivation for the skilled artisan to modify the '394 reference in such a manner. In view of the above, the § 103(a) rejection of claims 1-11 is improper and Appellant requests that it be reversed.

IV. Conclusion

In view of the above, and the underlying Appeal Brief, Appellant submits that the rejections of claims 1-11 are improper and therefore requests reversal of the rejections as applied to the appealed claims and allowance of the entire application.

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